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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/502,542

02/10/2000

Bruce L Davis

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DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER

FADOK, MARK A

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

05/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/502,542	Applicant(s) DAVIS ET AL.	
	Examiner MARK FADOK	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7,9,12-19,21,26,27,31 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) 3-7,12-19,21,31,34,35,36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Election

The examiner is in receipt of applicant's response to office action mailed 4/6/2009, which was received 4/10/2009. Acknowledgement is made to the election of Group III (claims 26 and 33) with traverse. Applicant argues that there would not be an undue burden and that the groupings were previously examined together. The examiner disagrees and notes that based on the previous office actions and the reply from the BPAI it is evident that prosecution 5 different inventions in one case was indeed burdensome and although the claims were examined earlier since as applicant points out the scope of the claims has changed the 5 new invention require a new search and consideration. This was particularly evident when the examiner had to reopen prosecution after applicant's pre appeal request. Applicant further states that all of the claims except for claim 31 are all in the same subclass. The examiner points out that there are 2,780 patents classified in 705/27, clearly there is a diversity of subject matter in this class/subclass that requires different search strategies to identify the claimed subject matter and that one search clearly will not work for all inventions in a subclass. Applicant further argues that the term catalog is not used in the claims. The examiner notes that it is well understood in the art that collections of products such as the listing databases referred to applicant's disclosure are commonly referred to as catalogs, such as a catalog of products.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cybul (US 6,246,997) in view of Deaton (US 6,993,498) and further in view of Definitions from Microsoft Dictionary.

In regards to claim 26, Cybul discloses a method comprising:
sensing indicia from selected items offered for sale in a bricks and mortar store
(Cybul, FIG 1, POS, by definition a POS is a (see Microsoft Dictionary) "Computerized

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transaction systems, such as those in use at automated supermarkets, use scanners for reading tags and barcodes...to record purchase”), and

compiling a list therefrom (Cybul, FIG 1, Item 12 List Builder Tool);

storing said list in a data structure associated with a user (updating history database col 3, lines 1-20 and col 4, lines 35-38);

said user later signing-on to an on-line store or virtual storefront over the internet, from a user's computer (Cybul col 5, lines 13-16 teach security and authentication at an ecommerce site authentication being defined in Microsoft's Computer Dictionary as "...the process by which the system validates a user's logon information" see also FIG 1, item 18 Shopper Browser);

said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer (col 1, line 60 – col 2, line 3); and

through use of a user interface of the user's computer, receiving input from the user identifying a subset of items from said customized selection of items, in connection with a purchase transaction of said subset of items from the on-line store or virtual storefront (col 1, lines 15-25, shopping online from a inventory, col 1, line 60 – col 2, line 3 online shopping improved though the use of an initial shopping list or “personal inventory” thus reducing the selection to ones that user has a preference);

Please note that the recitation “wherein the sensing of item indicia in the bricks and mortar store facilitates user shopping in an on-line store or virtual storefront, by enabling customization of the selection of items presented to the user by said online

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store or virtual storefront” is given little patentable weight. This recitation is considered a recitation of the intended use of the claimed invention and does not result in a structural difference between the claimed invention and therefore does not patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim (see MPEP 2106).

Cybul teaches collecting information such as UPC codes (Cybul, claim 7) at a POS of a vendor (first vendor) and saving that information in a database that generates customized lists for later online shopping, but does not specifically mention that the recalled list is used by a second vendor different from the first, to present a customized selection of items in an on-line store or virtual storefront. Deaton teaches using shopping lists that contain UPC codes to shop a plurality of different stores (Deaton FIG 12). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Cybul, using customized lists from one store to receive information from a second store, because this allows a customer to comparison shop thereby assure that the best offer is accepted and money is saved by the shopper.

In regards to claim 33, the combination of Cybul, Deaton and Microsoft Dictionary teach a method comprising: in connection with a user's expression of interest in a first item available for sale from a first vendor, adding information associated therewith to a data structure associated with the user; and recalling data from said data structure in connection with presenting to the user

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information about one or more items offered for sale by a second vendor;
wherein the first and second vendors are different (see response to claim 26).

Response to Arguments

Applicant's arguments with respect to claims 26 and 33 have been considered but are moot in view of the new ground(s) of rejection necessitated by the amendment filed 8/1/2008.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300

[Official communications; including

After Final communications labeled

"Box AF"]

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For general questions the receptionist can be reached at

571.272.3600

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/

Primary Examiner, Art Unit 3625